

Docket Code: AP.PRE.REQ

PTO/SB/33 (07/05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

96-082-C1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR

on December 1, 2005

Signature _____

Typed or printed name Veronika S. Leliever

Application Number

09/511,968

Filed

February 23, 2000

First Named Inventor

Jay S. Walker

Art Unit

2611

Examiner

3686

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 54,096

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Carson C. K. Fincham

Typed or printed name

203.461.7017

Telephone number

December 1, 2005

Date

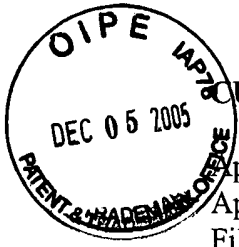
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 11 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



CUSTOMER NO. 22927

Applicants: Walker et al.
Application No.: 09/511,968
Filed: February 23, 2000
Title: METHOD AND SYSTEM FOR ALLOWING VIEWERS TO
PURCHASE PROGRAM PRODUCTS

Attorney Docket No.: 96-082-C1

Group Art Unit: 2611
Examiner: Hai V. Tran

**PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Final Office Action mailed July 1, 2005**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed July 1, 2005. No amendments are being filed with this request and this request is being filed with a Notice of Appeal. Review is requested for the reasons set forth in the remarks beginning on the following page.

REMARKS

I. Introduction

Claims 19-21 and 37-40 are currently pending in the present application. Claims 19, 20 and 37 are independent. All claims stand rejected. In particular, all claims (claims 19-21 and 37-40) stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 6,006,257 (hereinafter "Slezak"). Applicants respectfully traverse this ground for rejection as follows.

II. Claim Rejections under §103(a) – Slezak

All independent claims are directed to *entering product information relating to a product used in the entertainment program, wherein the product information includes information identifying how the product was used in the entertainment program.*

Currently claimed embodiments allow, for example, such information to be entered and stored so that program viewers may easily identify and purchase products or props shown or used during the program (e.g., by identifying a product based on how it was used during the program). Slezak simply does not teach or suggest *identifying how the product was used in the entertainment program.*

In response to Applicants' previous arguments, the Examiner disagrees with the contention that Slezak fails to teach or suggest the above-quoted limitation. In particular, the Examiner states:

"information identifying how the product was used in the entertainment program" reads on the "highlighted action" associates with the object, i.e., the truck or the highlighted truck. This "highlighted action" is identified by the system and is displayed along with the associated object (the truck) to the user. Thus, the "highlighted" action associated with an object is an information identifying how the associated object was used in the entertainment program, i.e., interactive or commercial or additional information, see Col. 4, lines 14-20.

Final Office Action mailed July 1, 2005 as Part of Paper No./Mail Date 06202005 (hereinafter "Final Office Action"), pg. 2, third paragraph.

Unfortunately, however, the Examiner's above-quoted statement is so unclear that Applicants cannot discern what the Examiner is attempting to convey. Applicants have analyzed both the Examiner's statement and Slezak and have been unable to identify how the cited section of Slezak (or any other section of Slezak) anticipates the limitation of *entering product information relating to a product used in the entertainment program, wherein the product information includes information identifying how the product was used in the entertainment program*. In particular, the Examiner's identification, use, and quotation of a "highlighted action" is confusing and possibly inappropriate. Nowhere in Slezak, for example, does the phrase "highlighted action" appear. Accordingly, Applicants are unable to ascertain the meaning of the Examiner's argument.

Slezak does describe, particularly at the cited section of Col. 4, lines 14-20, displaying advertising information to a viewer, where the advertising information is related to "a truck" shown in the viewed program. Nowhere, however, does Slezak describe *identifying how the product was used in the entertainment program*. It is entirely unclear how the Examiner believes that "if at some point a truck is highlighted in a scene", Slezak, Col. 4, lines 15-16, relates to an identification of how the truck is used in the program.

Further, the Examiner admits that Slezak fails to disclose a terminal coupled to a central controller, to enter such product data into a database. Final Office Action, pg. 3, bullet one. The Examiner goes on to state, however, that such a modification to Slezak would be obvious because the modification would allow the information to be provided to the user. *Id.*, at pg. 4, first paragraph. This conclusory and entirely unsupported assertion by the Examiner falls far short of providing an appropriate motivation to modify Slezak, as proposed by the Examiner, to establish a *prima facie* case of obviousness.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness at least because the Examiner has not shown how Slezak teaches or suggests the limitation of *entering product information relating to a product used in the entertainment program, wherein the product information includes information identifying how the product was used in the entertainment program*, or pointed to any motivation that would have led one skilled in the art to make the proposed modification

to Slezak. Applicants therefore respectfully request that the §103(a) rejections of claims 19-21 and 37-40 be withdrawn.

III. Conclusion

At least for the foregoing reasons, it is submitted that all claims are clearly in condition for allowance and Pre-Appeal Brief Review is requested to avoid the unnecessary expense of preparing an Appeal Brief in relation to the current rejections.

If there remain any questions regarding the present application or the cited reference, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-461-7017 or via e-mail at cfincham@walkerdigital.com, at the Examiner's convenience.

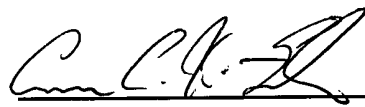
IV. Petition for Extension of Time to Respond

Applicants hereby petition for a **two-month extension** of time and authorize the charge of **\$225.00** to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

December 1, 2005
Date


Carson C.K. Fincham
Attorney for Applicants
Registration No. 54,096
Walker Digital, LLC
cfincham@walkerdigital.com
203-461-7017 /voice
203-461-7018 /fax